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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Jae Keol Rhee, <i>et al.</i>
App. No	:	10/596,412
Filed	:	June 13, 2006
For	:	NOVEL OXAZOLIDINONE DERIVATIVES
Examiner	:	Patricia L. Morris
Art Unit	:	1625
Conf No.	:	6355

**REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(b) AND 35 U.S.C. § 154(b)(3)(B)(ii)**

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants submit this Request for Reconsideration of the Patent Term Adjustment (PTA) in accordance with **37 C.F.R. § 1.705(b)** and **35 U.S.C. § 154(b)(3)(B)(ii)** to correct the PTA calculation of 138 days, as of the mailing date of the Notice of Allowance, by the United States Patent and Trademark Office (hereinafter the “Office”) to **864** days.

The Notice of Allowance was mailed on 12-24-09¹ and the Issue Fee has not been paid yet, and therefore this Request for Reconsideration is timely filed. No previous Request for Reconsideration under 37 C.F.R. § 1.705 was filed for the present patent application. As discussed more fully below, the requested correction of PTA arises from the Office’s errors in PTA calculation based on the vacated Restriction Requirement of 03-06-08 and the vacated Office Action of 01-29-09 during prosecution of the present patent application.

The \$200 fee set forth in 37 CFR 1.18(e) is provided herewith, in accordance with 37 C.F.R. § 1.705(b)(1).

¹ Date format herein is numerical “month-day-year”, i.e., 12-24-09 is December 24, 2009.

In accordance with 37 C.F.R. § 1.705(b)(2), the statements of facts are as follows:

1. In accordance with 37 C.F.R. § 1.705(b)(2)(i), Applicants submit that the correct PTA as of the mailing date of the Notice of Allowance is **864 days**. Applicants are entitled to PTA of 864 days due to Office delay under 35 U.S.C. § 154(b)(1)(A)(i) and 37 C.F.R. § 1.702(a)(1).²
2. In accordance with 37 C.F.R. § 1.705(b)(2)(ii), Applicants provide below the relevant dates as specified in §§ 1.703(a) through (e) for which an adjustment is sought and the adjustment as specified in § 1.703(f), to which the patent is entitled.
 - a. The Office's PTA determination listed on the Patent Term Adjustment History on PAIR does not properly account for all days of PTA under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. §§ 1.702(a) and 1.703(a). Applicants submit that they are entitled to **864 days** of PTA under **35 U.S.C. § 154(b)(1)(A)** and **37 C.F.R. §§ 1.702(a) and 1.703(a)** ("prosecution delays").
 - i. Applicants are entitled to a 864-day patent term adjustment due to the Office's 864-day delay in providing at least one of the notifications under 35 U.S.C. § 132 or a notice of allowance under 35 U.S.C. § 151 not later than 14 months after the filing date of the application, as provided in 35 U.S.C. § 154(b)(1)(A)(i)(II) and 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1). Specifically, the application was filed 06-13-06, and the first communication from the Office in compliance with 35 U.S.C. § 154(b)(1)(A)(i) and 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1) was the Notice of Allowance mailed 12-24-09. The time period between 06-13-06 and 12-24-09 is 14 months plus 864 days. Thus, the Office delay under 35 U.S.C. § 154(b)(1)(A)(i)(II) and 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1) was 864 days.
 - ii. The Patent Term Adjustment History on PAIR appears to have used the date of the Restriction Requirement mailed 03-06-08 to erroneously calculate the "prosecution delay" of 206 days under 35 U.S.C. § 154(b)(1)(A)(i)(II) and 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1). However, the Restriction Requirement mailed 03-06-08 was vacated according to the Interview Summary dated 12-07-09, and thus, the Restriction Requirement is void *ab initio*.³ Therefore, 03-06-

² Applicants also respectfully request additional days of PTA due to the Office's delay under 35 U.S.C. § 154(b)(1)(B) in a manner consistent *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. January 7, 2010).

³ According to Black's Law Dictionary (6th ed., 1990), "vacate" means "To annul; to set aside; to cancel or rescind. To render an act void; as, to vacate an entry of record, or a judgment...." In turn, Black's Law Dictionary defines "annul" as: "To reduce to nothing; annihilate; obliterate; to make void or of no effect; to nullify; to abolish; to do away with. To cancel; destroy; abrogate. To annul a judgment or judicial proceeding is to deprive it of all force

08 cannot be used as the date of a notification under 35 U.S.C. § 132 according to 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

3. In accordance with 37 C.F.R. § 1.705(b)(2)(iii), the present patent is not subject to a terminal disclaimer.
4. In accordance with 37 C.F.R. § 1.705(b)(2)(iv), there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704 (“applicant delay”).
 - i. The Patent Term Adjustment History on PAIR indicates the date of the Supplemental Non-Final Action as mailed 01-29-09, which appears to have been used erroneously to calculate the “applicant delay” of 12 days under 35 U.S.C. 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704(b) relating to the cumulative total of any periods of time in excess of three months that are taken to respond to a notice from the Office making any rejection, measuring such a three-month period from the date the notice was mailed to the applicant. However, the Supplemental Non-Final Action mailed 01-29-09 was vacated according to the Interview Summary of 12-07-09 and the Office Action mailed 02-11-09, page 2, line 1. Thus, the Supplemental Non-Final Action is void *ab initio*.⁴ Therefore, 01-29-09 cannot be used as the date from which an excess of three months can be calculated to respond to a notice from the Office under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704(b), and thus, the “applicant delay” of 12 days is incorrect, and should be zero days.
 - ii. In addition, the Patent Term Adjustment History on PAIR indicates the filing date of the Response after Non-Final Action as 05-11-09, which appears to have been used erroneously to calculate the “applicant delay” of 56 days under 35 U.S.C. 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R. § 1.704(c)(8), for the submission of a supplemental reply after a reply has been filed, that is, an Information Disclosure Statement filed 07-06-09. However, as discussed above, the Supplemental Non-Final

and operation, either *ab initio* or prospectively as to future transactions.” Black’s Law Dictionary defines “void” as: “Null; ineffectual; nugatory; having no legal force or binding effect; unable, in law, to support the purpose for which it was intended....” Applicants respectfully submit that “vacate” in the present context of e.g., “vacated Office Actions” means having no legal or binding effect, and therefore, the mailing dates of vacated Office Actions cannot have the legal effect, as they otherwise would have, in calculating Patent Term Adjustments. Applicants further submit that vacated Office Actions, which are unable to be used in calculating Patent Term Adjustments or have another legal effect, are deprived of force and operation *ab initio*.

⁴ See footnote 3.

Action mailed 01-29-09 was vacated according to the Interview Summary of 12-07-09 and the Office Action mailed 02-11-09, page 2, line 1, rendering the Supplemental Non-Final Action void *ab initio*.⁵ Therefore, 05-11-09 cannot be used as the date from which a supplemental reply, *i.e.*, an Information Disclosure Statement, can be calculated under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R § 1.704(b), as the vacated Supplemental Non-Final Action did not have the legal effect of requiring a “reply” and therefore, the Information Disclosure Statement cannot be considered a “supplemental reply.” Thus, the “applicant delay” of 56 days is incorrect, and should be zero days.

The proper PTA as of the date of the Notice of Allowance is the sum of non-overlapping “prosecution delays” minus any debit days for “applicant delay” under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R § 1.704. Applicants are entitled to a PTA of 864 days under 35 U.S.C. § 154(b)(1)(A) and 37 C.F.R. §§ 1.702(a) and 1.703(a). There is no reduction of days for “applicant delay” under 35 U.S.C. § 154(b)(2)(C) and 37 C.F.R § 1.704. Thus, Applicants submit they are entitled to the sum of 864 days of “prosecution delay” as of the mailing date of the Notice of Allowance minus 0 days of “applicant delay,” for a **total patent term adjustment of 864 days**.

Applicants hereby request that the Office correct the calculation of PTA as of the mailing date of the Notice of Allowance to reflect 864 days.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 11-1410.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 5, 2010 By: /Carolyn Favorito/

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⁵ See footnote 3.